

**REMARKS**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, Claims 7 and 11 have been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner rejected Claims 7-10 under 35 U.S.C. §102(b) as anticipated by and Claim 11 under 35 U.S.C. §103(a) as being obvious over Chromy, U.S. Patent No. 3,690,390 (Chromy) or Klein, U.S. Patent No. 5,775,445 (Klein).

It is respectfully submitted that Claims 7-11 are patentable over the cited references.

Specifically, both Claims 7 and 11 recite a one-piece drilling head formed completely of a hard material and comprising a main bit and at least one auxiliary bit arranged on a same surface as the main bit . . .

No such drilling head is disclosed in either of Chromy or Klein. Both disclose a two-piece drilling head formed of a center drill and surrounding the center drill, crown drill. Chromy does not disclose the material of the center and crown drills but considering that both are provided with cooperating threads, they could not be made of hard material, as that would have made formation of the thread very difficult. The same applies to Klein. In Klein, only the cutting elements appears to be formed of a hard material. Further, in both Chromy and Klein, the main and auxiliary bits are not arranged on the same surface.

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Bariant Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . . [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See

also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Since both Chromy and Klein fail to disclose each and every feature of independent Claims 7 and 11, neither, as a matter of law, anticipates the present invention, as defined by said independent claims.

In view of the above, it is respectfully submitted that neither Chromy nor Klein anticipates or makes obvious the present invention as defined in Claims 7 and 11, and the present invention is patentable over both Chromy and Klein.

Claims 8-10 depend on Claim 7 and are allowable for the same reasons Claim 7 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 7 are not disclosed or suggested in the prior art.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,

Alexander Zinchuk  
Alexander Zinchuk  
Reg. No. 30,541

Dated: February 13, 2003  
Sidley Austin Brown & Wood LLP  
787 Seventh Avenue  
New York, N.Y. 10019  
Tel.: (212) 839-7365

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 13, 2004.

Alexander Zinchuk

Signature: Alexander Zinchuk